SEP 10 1952
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1952.

No. 286

HOLLAND COMPANY,
Petitioner,

vs.

AMERICAN STEEL FOUNDRIES,
Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITIONER'S APPLICATION FOR WRIT OF CERTIORARI.

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The Scheffer Press, Inc.—ANdover 3-6850

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STATEMENT OF THE CASE.

This is a patent infringement action. The District Court and the Court of Appeals agreed that the single claim in issue of the patent in suit is invalid because it is anticipated by the prior art and because it does not exhibit invention over the prior art (R. Vol. 2, 6-10 and 22-27).

This case was twice before the Court of Appeals. Upon the first appeal from a judgment of the District Court dismissing the complaint because there was no infringement (R. Vol. 1, 181), the Court of Appeals reversed stating: "* * * the only issue within the scope of the review here is that of infringement." (R. Vol. 1, 268, 190 F. (2d) 37, June 7, 1951).

The Court of Appeals remanded the cause for appropriate findings upon the issue of validity which the Court directed should be made by the District Court (R. Vol. 1, 271-272). Thereupon the District Court made findings that claim 10 of the patent in suit is invalid, explicitly finding each element of that claim in each of four prior art patents, and ordering the complaint dismissed (R. Vol. 2, 6-11). The Court of Appeals affirmed the judgment (R. Vol. 2, 22-27, 196 F. (2d) 749, April 29, 1952).

Petitioner challenges the decree of the Court of Appeals upon two grounds: first, that the finding of invalidity by the District Court and the affirming decision of the Court of Appeals are in conflict with the decision of the Court of Appeals on the first appeal (Pet. pp. 8-10); second, that the subsequent decision of the Court of Appeals on the validity issue is in conflict with other decisions of the same Court as to the meaning of Rule 52(a) of the Federal Rules of Civil Procedure (Pet. pp. 11-14).

The Court of Appeals' Decisions on Invalidity and Infringement Do Not Conflict.

Both the Court of Appeals and the District Court have found that every element of Claim 10, the only claim in suit, was found in the prior art Ritter patent and particularly in the modified form described in its specification. There is nothing in the Court of Appeals' earlier opinion that conflicts with these determinations. Nor did the Court of Appeals in its second decision ignore its previous decision as petitioner suggests (Pet. p. 9). In its second opinion (R. Vol. 2, 27) the Court of Appeals gave heed to its first opinion saying:

> "• • • As the previous opinion of this court shows, defendant's accused structure embodied an improvement over the Goodwin patent in suit but, notwith-

standing, this court found infringement because it was a 'difference only in degree.' And as defendant's improvement was not such as to permit it to escape infringement, any improvement by Goodwin was not such as to permit it to escape anticipation by Ritter. We find no occasion to discuss other prior art patents relied upon by the District Court."

The Requirements of Rule 52(a) Were Fully Met by the Court of Appeals.

The Court of Appeals' application of Rule 52(a) was correct whatever interpretation petitioner would give to that rule and the decisions of this Court and the Court of Appeals construing it. In its opinion here under attack, the Court of Appeals not only gave full heed to Rule 52(a) in its recognition that the District Court findings of fact may not be set aside unless "clearly erroneous", but went further and itself examined the prior art and concurred in the District Court's findings. In its opinion the Court of Appeals stated with respect to the conclusiveness of the District Court's findings (R. Vol. 2, 24):

"• • • We are convinced that the District Court did a credible job in his analysis of these prior art disclosures and that their application to the claim in suit justified his finding of invalidity. In any event, we are in no position to say that it was 'clearly erroneous'."

The Court of Appeals' agreement with the District Court's finding of invalidity of the patent in suit based upon its own independent investigation of the prior art is found in its opinion (R. Vol. 2, 26):

"We think that the patent in suit is invalid in view of Ritter. We agree with the District Court that any improvement shown was such as to come within the domain of the skilled mechanic."

CONCLUSION.

Respondent submits that no occasion exists for granting the application for the writ of certiorari.

Respectfully submitted,

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